

REMARKS

Claims 1-12 are pending in the application.

Claims 1-12 have been rejected: claims 1, 9 and 12 under §102(b) as being anticipated by Honda, et al. (U.S. Patent No. 6,041,195); and claims 2-8 and 10-11 under §103(a) as being anticipated by the combination of Honda and Acker (U.S. Patent No. 5,742,859).

Claims 1-3, 5, 6, 9-10 and 12 have been amended. Claims 1-2, 6 and 9-10 have been amended to add features from dependent claims, and claims 3, 5 and 12 to change their dependencies to now-amended claims.

Reconsideration of the pending claims is respectfully requested in light of these amendment and the following remarks.

Claim Rejections – 35 U.S.C. § 102

Claims 1, 9 and 12 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Honda, et al. (U.S. Patent No. 6,041,195).

These rejections are obviated by the amendments made to the claims. Namely, claims 1 and 9 are directed to devices having camera bodies and handles and dedicated buttons for still and video imagery. No such structure (or function) is found in a single source of the prior art of record and, for the reasons expressed below, would not be obvious to combine from the various prior art patents noted by Examiner.

Claim Rejections – 35 U.S.C. § 103

Claims 2-8 and 10-11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Honda, et al., in view of Acker (U.S. Patent No. 5,742,859).

1. Applicable Law Concerning §103(a) Rejections

The Federal Circuit has been consistent in reversing the PTO when a rejection is made on the basis of hindsight, that is when an Examiner rejects the application under 35 U.S.C. §103(a) grounds as obvious under a combination of two or more patents without any specific suggestion within the patents to combine the features. *In re Rouffett*, 47 USPQ2d 1453 (Fed. Cir. 1998), the Federal Circuit refused to uphold an obviousness rejection, even where skill in the art is high, absent the specific identification of principal, known to one of ordinary skill in the art that suggests the claimed combination.

The Federal Circuit reemphasized the care to be taken when combining prior art references in obviousness findings in *Ecolochem v. Southern Cal. Edison*, 56 USPQ2d 1065 (Fed. Cir. 2000), stating that such absence of evidence to combine prior art references “is

defective as hindsight analysis." The Federal Circuit held similarly in *In re Kotzab*, 55 USPQ2d 1313 (Fed. Cir. 2000), reversing the PTO and stating that, "[i]dentification of prior art statements that, in abstract, appear to suggest claimed limitation does not establish prima facie case of obviousness without finding as to specific understanding or principal within knowledge of skilled artisan that would have motivated one with no knowledge of the invention to make the combination in the manner claimed."

Finally, the Federal Circuit has reaffirmed their view that the PTO used improper hindsight analysis to reject patent claims under §103(a) in the recent case of *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), stating that a specific suggestion in the prior art cited is required and not a simple citation to "common knowledge and common sense." *Lee* includes a tour-de-force of case law directed to the issue of combining references including those as follows:

- "The factual inquiry whether to combine references must be thorough and searching. . . It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with." (*Lee*, 277 F.3d at 1343)
- "A showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding." (quoting, *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000))
- "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." (quoting, *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998))
- "There must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant." (quoting, *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998))
- "Teachings of references can be combined *only* if there is some suggestion or incentive to do so." (quoting, *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (emphasis in original))

The Patent Office has failed to display the rigor required by the Federal Circuit holdings in demonstrating a suggestion within the art that the cited prior art references should be combined.

2. Application of the Law to the Present Claims

With respect to claims citing to a camera body including a handle (now including all amended claims), the Examiner states that Honda does not expressly disclose a handle but that Ackers does. Further, the Examiner states that it would be obvious to one of ordinary skill in the art at the time to modify Honda by including the Ackers handle for support and stabilization.

This application of hindsight is just the activity that the Federal Circuit warns about. Honda includes a molded portions on the left and right sides of the camera body (see FIG. 3) to allow a user to grip and steady the camera with both hands. This design is common with single reflex cameras and has been unaltered for many decades. To add a handle to such a design as shown in Honda would defeat decades of engineering refinement.

Ackers recognizes the drawbacks to handles used in video cameras. In the Background of the Invention section (Col. 1, lines 34-63), Ackers discloses three patents that teach a foldable "equipoising arm" that has a surface on which to mount the camera with a two part handle. Ackers then proceeds to outline the problems with such devices such as imposing unwanted movements of the operator into the video images, as well as the non-isolation of the arms on/off switch from the body of the camera. Ackers further discloses there are problems with balancing the camera about the handle, and the fatigue of the user induced by using the handle to support the camera body. Ackers provides a complicated mechanical solution involving various additional pivot arms and the like (see, e.g., FIGs. 2, 4, 6 and 8) to supplement the handle grip. Given the extreme differences in uses, structure and operation of the Honda and Ackers cameras, combination of the references would not be obvious to one skilled in the art.

Specific comments about the remaining claims are as follows:

In claims 2 and 10, the Ackers handle is on a pivot and is not fixedly attached to the camera.

In claim 6, there is no mode disclosed in Honda (see, e.g., the modes 1, 2, 3, and 4 disclosed in Col. 15, line 4 through Col. 16, line 28) that allows both the still and video buttons to be active while observing images through the view-finder. Mode 1, for instance, only allows use of the LCD screen at the back of the camera while buttons S1 and S2 are active. Mode 2 allows simultaneous shooting of film and still shots while viewing through

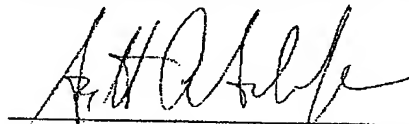
LCD screen, Mode 3 allows only film shots through the viewfinder, and Mode 4 allows simultaneous shooting of film and still (but not video) shots through the viewfinder. No other modes are noted or suggested in Honda that would teach the limitations of claim 6.

CONCLUSION

For the foregoing reasons, reconsideration and allowance of claims 1-12 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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